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March 11, 2005
Date

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PATENT CLFR:190US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Lee et al.

Serial No.: 09/714,692

Filed: November 16, 2000

For: METHOD OF INHIBITING ANGIOGENESIS BY ADMINISTRATION OF A CORTICOTROPIN RELEASING FACTOR RECEPTOR 2 AGONIST

Group Art Unit: 1647

Examiner: Bunner, B.

Atty. Dkt. No.: CLFR:190US

REPLY BRIEF

MS Appeal Briefs-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants hereby submit an original and two copies of this Reply Brief to the Board of Patent Appeals and Interferences in response to the Examiner's Answer mailed January 11, 2005 (the "Answer"), making the present Reply Brief due on March 11, 2005. It is believed that no fee is due in connection with the filing of this Reply Brief. However, the Commissioner is authorized to deduct any required fees for any reason relating to this document under 37 C.F.R.

§§ 1.16 to 1.21 from Fulbright & Jaworski L.L.P. Deposit Account No. 06-2375, under Order No. CLFR:190 US. We have enclosed herewith a request for oral hearing.

In the present Reply Brief, rather than reiterating arguments set forth in the underlying appeal brief, Appellants will instead simply address the comments made by the Examiner.

Notably, the Answer affirms that Villalona-Calero *et al.* do not teach an inhibition of angiogenesis in the tumor or tumor vasculature and even concedes that the reference does not teach a relationship between angiogenesis and vascular leakage. As such, Appellants contend that the Examiner has failed to make out a *prima facie* anticipation, and has failed to provide a reasoned explanation of how a discussion of inhibition of vascular leakage of plasma constituents or actions on brain tumor microvasculature in Villalona-Calero *et al.* would lead one with skill in the art to the conclusion that human CRF inhibits angiogenesis in brain tissue. The Examiner admits that there is no discussion of angiogenesis, and no relationship between angiogenesis and vascular leakage. Therefore, it is clear that Villalona-Calero *et al.* does not make reference to the administration of human CRF for the inhibition of angiogenesis.

Moreover, the present invention is directed to inhibiting angiogensis in a target tissue – not to the treatment of vascular leakage. There is simply no motivation or suggestion or teaching from Villalona-Calero *et al.* that CRF is in any way useful in inhibiting angiogensis.

The Answer argues that since Villalona-Calero *et al.* discuss the administration of human corticotrophin releasing factor (a CRFR2 agonist) to the same subject population and to the same tissue as recited in the claims, inhibition of angiogenesis must have been inherently occurring in the prior art.

Appellants strenuously disagree. In maintaining a rejection solely on the basis of inherency, the Examiner must fully explain how the reference anticipates, which has not been

done here. Moreover, if a claimed method comprises steps identical to those of a method practiced in the prior art, and the same result would have been achieved in the prior art method, the "accidental or unwitting achievement of that result cannot constitute anticipation." *In re Marshall,* 578 F.2d 301, 198 USPQ 344 (CCPA 1978). In *Marshall*, the claims were directed to a weight control process comprising the administering of an anesthetic such as oxethazaine to inhibit release of hormones, thereby preventing release of pancreatic enzymes that would otherwise digest food passing through the digestive tract. The cited reference was the Physician's Desk Reference (PDR), which disclosed use of oxethazaine for treatment of esophagitis, gastritis, peptic ulcer and irritable colon syndrome, and disclosed that this anesthetic inhibited release of the acid-stimulating hormone, gastrin. The CCPA held that the PDR did not disclose every material element of the claimed subject matter because the claims were directed to a weight control process and nothing in the PDR remotely suggested taking oxethazaine to lose weight. The court added that "[i]f anyone ever lost weight by following the PDR teachings it was an unrecognized accident." Appellants reiterate that *Marshall* is binding precedent, as it has never been overturned.

Marshall applies to instant claims. The cited reference discusses human CRF to treat edema in brain tissue. Although the patient population consist of patient with brain tumors, the reference is directed towards treatment of a side effect of those tumors, namely edema. Any effect on angiogenesis in the patients could only be characterized as an unrecognized accident, since the Villalona-Calero *et al.* study did not discuss angiogenesis. As Appellants have already established that no teaching of Villalona-Calero *et al.* would lead one with skill in the art to

determine that human CRF would have an effect on angiogenesis, there can be no finding of anticipation.

Dated: March 11, 2005

Respectfully submitted,

By _____

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